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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,795	06/19/2001	Ronald J. Scherer	3616.177US12	4387

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MERCHANT & GOULD PC  
P.O. BOX 2903  
MINNEAPOLIS, MN 55402-0903

EXAMINER

LEE, JONG SUK

ART UNIT PAPER NUMBER

3673

DATE MAILED: 06/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/884,795

Applicant(s)

SCHERER ET AL.

Examiner

Jong-Suk (James) Lee

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23, 29-42 and 54-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 22, 23 and 29-41 is/are rejected.
- 7) ☒ Claim(s) 15-21, 42 and 54-70 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 20 May 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12 & 17.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION**

1. The amendment filed May 20, 2003 has been entered.
2. It is noted that applicant should present the clear line of distinction between the claims of the present application and copending applications (Serial No. 09/691,864) in order to avoid possible double patenting.

***Drawings***

3. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on May 20, 2003 have been approved by the examiner.

***Claim Objections***

4. Claims 15-21, 42 and 54-70 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter "the masonry block" of a previous claim. Instead, these dependent claims refer the structural element of the splitting assembly.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Accordingly, the claim not been further treated on the merits.

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***Claim Rejections - 35 USC § 112***

1  
2 5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

3 The specification shall conclude with one or more claims particularly pointing out and  
4 distinctly claiming the subject matter which the applicant regards as his invention.  
5

6 6. Claims 1-14, 22, 23 and 29-41 are rejected under 35 U.S.C. 112, second paragraph, as  
7 being indefinite for failing to particularly point out and distinctly claim the subject matter which  
8 applicant regards as the invention.

9 Re claims 1, 29 and 40: The preambles, "A masonry block" of the claims functionally  
10 recites the splitting (blade) assembly as the preamble limitation and further positively recite  
11 the masonry block such as, "the masonry block comprising....." or "whereby the masonry  
12 block includes.....". The claim must be clarified as to whether the claim is drawn to the  
13 subcombination, the masonry block alone or the combination of the block and splitting  
14 assembly.

15 Appropriate correction is required.  
16

17 ***Claim Rejections - 35 USC § 102***

18 7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the  
19 basis for the rejections under this section made in this Office action:

20 A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 29, 30, 35, 36, 40 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Dean, Jr. (US 4,335,549).

The preamble limitation, "resulting from a splitting operation..." in claim 1, "that is produced from a molded workpiece...." in claims 29 and 40 is considered to be functional and part of the preambles. Therefore, patentable weight is not given to the preamble limitations.

Dean, Jr. discloses a masonry block splitted by a block split assembly (see Figs. 5, 7, 9), the masonry block comprising at least one irregular edge and surfaces (24, 47) produced by the splitting assembly splitting and breaking away portions of the workpiece (12, 13) during the splitting operation and an opposed pair of irregular edges, the irregular split surface is mottled (see Figs. 1-4; col.4, lines 12-68; col.5, lines 1-50).

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b).

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1 Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the  
2 AIPA (pre-AIPA 35 U.S.C. 102(e)).  
3

4 10. Claims 1-14, 22, 29-36, 40 and 41 are rejected under 35 U.S.C. 102(e) as being  
5 anticipated by Sievert (US 6,082,057).

6 Sievert discloses a masonry block (10) splitted by a block split assembly, the masonry  
7 block comprising: a block body including a top surface (11), a bottom surface, a front surface  
8 (146) extending between the top and bottom surfaces and being generally rounded when viewed  
9 from the side, a rear surface extending between the top and bottom surfaces, and side surfaces  
10 between the front and rear surfaces; a locator protrusion having a locator lip (18, 20), formed  
11 integrally with the block and disposed on the top of bottom surface thereof; the intersection of the  
12 front surface and the top surface defining an upper edge, and the intersection of the front surface  
13 and the bottom surface defining a lower edge; and wherein at least a portion of the front surface  
14 and at least a portion of either the upper edge or the lower edge are roughened as a result of the  
15 splitting assembly splitting and breaking away portions of the workpiece during the splitting  
16 operation, wherein at least one roughened upper edge or lower edge being rounded, wherein a  
17 portion of at least one of the side surfaces is textured as a result of the action of the work-piece-  
18 forming mold, the textured portion of the at least one side surface is adjacent the front surface or  
19 the entire side surface; a radiused section connecting the front surface to at least one of the side  
20 surfaces and being textured as a result of the action of the workpiece-forming mold, the front

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1 surface is mottled and a plurality of colors in the material forming the masonry block; a wall  
2 formed from a plurality of masonry block as depicted in Fig. 5 (see Figs. 1-6; col.3, lines 8-67;  
3 col.4, lines 1-45).

4  
5 ***Claim Rejections - 35 USC § 103***

6 11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness  
7 rejections set forth in this Office action:

8 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in  
9 section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are  
10 such that the subject matter as a whole would have been obvious at the time the invention was made to a person  
11 having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the  
12 manner in which the invention was made.

13 This application currently names joint inventors. In considering patentability of the claims  
14 under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was  
15 commonly owned at the time any inventions covered therein were made absent any evidence to  
16 the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor  
17 and invention dates of each claim that was not commonly owned at the time a later invention was  
18 made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35  
19 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).  
20

21 12. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sievert in view of  
22 MacDonald (US 6,149,352). The teachings of Sievert have been discussed above.

23 However, Sievert fails to disclose or fairly suggest a wall having a plurality of different  
24 sizes of the masonry block. MacDonald discloses a retaining a wall block system comprising of a  
25 plurality of different sizes of the masonry block as depicted in Fig. 2 and 3A (see col.9, lines 35-

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67; col.10, lines 1-4).

Therefore, in view of MacDonald, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to provide the different sizes of the splitted masonry block in constructing the wall in order to enhance the aesthetic appearance for the wall.

### ***Obviousness-Type Double Patenting***

13. The nonstatutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and © may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 37-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 27 of U.S. Patent No. 6,321,740.



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1           Although the conflicting claims are not identical, they are not patentably distinct from each  
2 other because the present claimed invention is somewhat broader recitation of the '740 patent, for  
3 example, in claim 37 of present claimed invention and claim 27 of '740 Patent, the Applicants  
4 claim: " .... providing a first block splitting assembly that includes one or more splitting members  
5 positioned to define a splitting line and to engage a masonry workpiece to split it generally along  
6 the splitting line when the splitting assembly is activated and that includes a plurality of  
7 projections adjacent the splitting line on at least one side thereof, .....aligning a masonry  
8 workpiece with the splitting line and activating the first splitting assembly."

9           Whereas in '740 Patent, the Applicants claim: ".....providing first and second opposed  
10 splitting blade assemblies, said first blade assembly comprising a first splitting blade having first  
11 and second sides, said first assembly comprising a plurality of projections adjacent said first  
12 splitting blade first side and a plurality of projections adjacent said first splitting blade second side,  
13 said second blade assembly comprising....so that they travel into the masonry block as it is split by  
14 said splitting blade assemblies; and striking the masonry block with said first and second opposed  
15 splitting blade assemblies, whereby said projections contribute to the formation of irregular split  
16 edges and surface on the resulting split pieces of the masonry block."

17  
18           Therefore, in respect to above discussions, it would have been obvious to one of ordinary  
19 skill in the art at the time the invention was made to use the teachings of claims 27 of '740 patent

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1 as a general teachings for a method of producing a masonry block produced having at least one  
2 irregular split edge and surface during a splitting operation as claimed by the present application.

3 The instant claims obviously encompass the claimed invention of '740 Patent and differ  
4 only in terminology. To the extent that the instant claims are broaden and therefore generic to the  
5 claimed invention of '740 Patent [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states  
6 that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been  
7 previously been claimed in a co-pending application.

8  
9 ***Response to Arguments***

10 15. Applicant's arguments with respect to claims 1, 29 and 40 have been considered but are  
11 moot in view of the new ground(s) of rejection.

12 16. Applicant did not present the argument with respect to the obviousness-type double  
13 patenting rejections with respect to claims 37-39 and therefore, Examiner's burden for the  
14 rebuttal to the Applicant's arguments does no longer exist.

15  
16 ***Allowable Subject Matter***

17 17. Claims 37-39 would be allowable over the prior art of record upon timely filing terminal  
18 disclaimer.

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**Conclusion**

1  
2 18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office  
3 action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is  
4 reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

5 A shortened statutory period for reply to this final action is set to expire THREE  
6 MONTHS from the mailing date of this action. In the event a first reply is filed within TWO  
7 MONTHS of the mailing date of this final action and the advisory action is not mailed until after  
8 the end of the THREE-MONTH shortened statutory period, then the shortened statutory period  
9 will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR  
10 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,  
11 will the statutory period for reply expire later than SIX MONTHS from the date of this final  
12 action.

13  
14 19. Any inquiry concerning this communication or earlier communications from the examiner  
15 should be directed to Jong-Suk (James) Lee whose telephone number is (703) 308-6777. The  
16 examiner can normally be reached between the hours of 6:30 AM to 3:00 PM Monday thru  
17 Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,  
18 Heather C. Shackelford, can be reached on (703) 308-2978. The fax phone number for this  
19 Group is (703) 305-3597.


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1 Any inquiry of a general nature or relating to the status of this application or proceeding  
2 should be directed to the Group receptionist whose telephone number is (703) 308-2168.

3 J. Lee /jjl  
4 June 25, 2003  
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8

  
Jong-Suk (James) Lee  
Primary Examiner  
Art Unit 3673